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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,912	12/30/1999	PERRY A. PIERCE	E-925	7042

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EXAMINER

ZURITA, JAMES H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 04/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/475,912

Applicant(s)

PIERCE, PERRY A.

Examiner

James Zurita

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Application filed 30 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show Figures 4-7 as described in the specification. In addition, textual description of Fig. 1, on pages 6-7, shows a plurality of users as items 11-16. Fig. 1 depicts users as items 1-6. The description on page 6 for Fig. 1 correctly identifies a software program as item 50. However, the description on page 8, line 2 for Fig. 2, identifies the software program as item 60. There is no item 60 in either Fig. 1 or Fig. 2.

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states, "having a seller s account and a buyer s account". This appears to be word processing error and should be changed to "having a seller account and a buyer account."

Claim 7 states "to access the seller s account." This should be changed to "access the seller account."

Claims 1, 6 and 7 are directed to an *account*. As used in the specification the word account is described as accepting monetary value (see at least application page 2, line 27 – page 3, line 10; page 9, lines 9-26). In contrast, Claim 1 states, "(ii) information storage . . . and the monetary storage so as to store a fund deposited by the buyer to pay for downloading the data item into the buyer account . . . ." As used in Claim 1, a buyer downloads a data item into a buyer account. This use is inconsistent with the usual meaning of the term account and the use of the word account as defined by applicant.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Applicant discloses that a user (either a buyer or a seller) may upload/download data (see at least application, page 10, lines 1-5). The term "upload" in claim 20 is used by the claim to mean "copy a [excerpt] file from a service provider to a buyer computer," while the accepted meaning is the reverse. Claim 20 states "wherein an excerpt of the data item is used for the

buyer to review the data item before *downloading* the data item, said method further comprising the step of *uploading* an electronic file containing the excerpt to the buyer.” Thus, applicant uses the terms *download* and *upload* to describe the process where a user who is a buyer obtains information from a service provider. Claims 1, 2, 8, 11, 14, 15-20, 23 and 24 refer to download in the accepted meaning of the term, that is, *download*[-ing] a data item [from a repository].

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims x-y are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenberg et al. US Patent 6,363,357-B1.

As per claims 1 and 17, Rosenberg et al. disclose a system and method via a service provider to allow a seller to store a data item that the seller wishes to sell electronically to a buyer for a fee, said repository system comprising:

- a data storage for storing data items, information storage (post fee) and monetary storage (see at least references to files at merchant web site at web site service

provider host; see at least item 508 and related text concerning posting a file; see at least Col. 5, line 10-Col. 7, line 53);

- having a sellers account (see at least references to merchant account, Col. 7, line 54-Col. 8, line 30) and a buyers account (see at least references to buyer vault and buyer account, Col. 4, line 22-Col. 5, line 33, Col. 7, line 54-Col. 8, line 19)
- the information storage is for posting the fee for downloading the data item from the data storage; said data repository system further comprising communication program(s) to link data storage, information storage and monetary storage (see at least references to program functions in Figs. 3-9, and related text concerning linking operations performed by programs to communicate information among the item storage, information storage and money storages; see also at least Col. 5, line 7-33, Col. 6, line 40-Col. 7, line 15);
- to allow the buyer to download the data item from the data storage (see at least Abstract, Col. 2, lines 44-58, Col. 5, line 34-Col. 7, line 54, Col. 8, lines 20-30, Col. 9, line 47-Col. 10, line 44; and
- to deduct a monetary sum from the deposited [buyer] fund according the posted fee in the information storage and credit the monetary sum to a seller account (see at least item 644, Fig. 6 and related text in Col. 6, line 40-Col. 8, line 19 concerning debiting a buyer account and crediting a seller account).

As per claim 2, Rosenberg et al. disclose the system of claim 1 wherein the buyer deposits the fund in the monetary storage prior to downloading the data item (see Fig. 4 and related text concerning 'refill'; see also at least Col. 4, line 55-Col. 5, line 34).

As per claims 14, 15, 21 and 22, Rosenberg et al. disclose the system and method wherein the fund is deposited in a bank or stored in a stored value card and the deposited/stored fund can be withdrawn by a data repository system to pay a seller (see at least references to bank, payment broker and credit company, Fig. 1, 2 and related text; see also at least Col. 7, line 54-Col. 8, line 19 concerning payment processing, and how buyers can withdraw and refill their funds from a bank. It is inherent in payment systems that debit cards, stored value cards, bank cards, among others, may be used interchangeably to pay for goods. Fig. 6, item 634, shows a step that checks whether there are funds available in a buyer account. This process carries out functions that allow a data repository to withdraw funds from bank).

As per claim 3, Rosenberg et al. disclose the system wherein a fee deducted from a fund deposited by a buyer may be credited to a seller (see at least Col.7, line 54-Col. 8, line 55, describing processes where a merchant account may be credited).

As per claims 4 and 5, Rosenberg et al. disclose that a seller's account may be credited with buyer payments and that a seller's account may then be debited to execute a payment in the form of a fee and/or a commission to a service provider for using the data repository (See at least Col. 12, line 49-58 concerning charges to a merchant's account for services used at the service provider. See also Col. 8, line 20-Col. 9, line 15 concerning debits to merchant account. Where amounts can be debited to a merchant account, the types of debits and their frequency are irrelevant).

As per claim 6, Rosenberg et al. disclose monetary storage that includes an account for a seller to store fees credited to him (see at least Fig. 1-3 and related text

concerning how a seller may set up an account that is then used to store information concerning payments made to seller by buyers. See also Col. 4, line 7-Col. 6, line 8, and discussion concerning claims 3-5, above).

As per claims 7 and 10, Rosenberg et al. disclose a seller using identification code to access the seller's account and to update data item(s) and/or related fee (See at least Col. 5, lines 33-Col. 6, line 39, Col. 7, lines 16-53 concerning merchant identification code and how a merchant accesses his information to place items for sale. See also at least Fig. 3 and related text concerning merchant registration process, creates and accesses related account information).

As per claims 8 and 18, Rosenberg et al. discloses the system and methods of claims 2 and 17, respectively, wherein the fee for downloading the data item has a range specified by the seller and defined by a maximum amount and a minimum amount, posting the maximum amount as the fee for downloading a data item, and the monetary sum deducted from the fund deposited by the buyer is equal to a price offered by the buyer wherein the offered price falls within the fee range as specified by the seller (see at least Col. 11, lines 1-64).

As per claims 9 and 19, Rosenberg et al. disclose the system and method of claims 8 and 19, respectively, to automatically check the offered price by the buyer in order to determine whether the posted offer falls within the fee range as specified by the seller (see at least references to bank, payment broker and credit company, Fig. 1, 2 and related text; see also at least Col. 7, line 54-Col. 8, line 19 concerning payment processing, and how buyers can withdraw and refill their funds from a bank. It is



inherent in payment systems that debit cards, stored value cards, bank cards, among others, may be used interchangeably to pay for goods. Fig. 7 displays product information, including a price and a buyer can press the buy button to purchase an item. Fig. 6, step 634, checks whether there are funds available in a buyer account. This process carries out functions that allow a data repository to withdraw funds from bank. See at least Col. 6, line 40-col. 7, line 15).

As per claims 11, 13 and 20, Rosenberg et al. disclose the storage and use of an excerpt of a data item so as to allow the buyer to obtain the excerpt, preview the excerpt without the possibility of downloading the data item without paying the seller (see at least Figs. 2, 6, 7 and items 216, 600, 610, 612. See also at least Col. 6, line 40-Col. 7, line 15. These figures and sections describe previewing a product by downloading a related excerpt, paying a seller, and downloading the product).

As per claim 12, Rosenberg et al. disclose the use of a hosting service to manage sophisticated financial transactions on the World Wide Web (see at least Col. 1, line 13-Col. 2, line 41). It is an inherent function of such hosts to provide services that include administration services, such as password administration, certificates and key management. Among their fiduciary responsibilities, which are usually based on contracts, service providers notify users of the host regarding problems.

As per claims 16, Rosenberg et al. disclose that a data item may be encrypted prior to a buyer downloading the data item (see at least Abstract, Col. 2, lines 44-67, Col. 4, lines 22-54, Col. 5, lines 34-69, Col. 7, line 16-Col. 19, line 19, Col. 9, line 47-Col. 10, line 13, Col. 12, lines 49-58).

As per claims 23 and 24, Rosenberg et al. disclose the use of digital signatures and digital certificates (see at least references to SSL, Secure Socket Layer protocol developed by NETSCAPE COMMUNICATIONS® for transmitting private documents via the Internet. SSL works by using a private key to encrypt data that is transferred over an SSL connection. See at least Col. 5, lines 1-33, Col. 7, lines 16-53. See also at least Fig. 4, steps 410-414 which discusses the use of certificates, and at least Col. 4, line 55-Col. 5, line 33).


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8:30 am to 5:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-395-3900.

J2  
**James Zurita**  
**Patent Examiner**  
**Art Unit 2165**  
April 19, 2002

  
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